

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1, 5-10, 14-19, 23-28, and 32-36 are pending in this application. Claims 2-4, 11-13, 20-22, and 29-31 are canceled by the present response without prejudice. Claims 1, 2, 5, 7, 10, 11, 14, 16, 19, 20, 23, 25, 28, 29, 32, and 34 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. patent 6,643,696 to Davis et al. (herein "Davis") in view of U.S. patent 6,363,407 to Middleton, III et al. (herein "Middleton") and U.S. patent 5,333,302 to Hensley et al. (herein "Hensley"). Claims 8, 17, 26, and 35 were rejected under 35 U.S.C. § 103(a) as unpatentable over Davis, Middleton, and Hensley as applied to claims 1, 10, 19, and 28, and further in view of U.S. patent 6,336,141 to Fujiyama et al. (herein "Fujiyama"). Claims 3, 6, 12, 15, 21, 24, 30, and 33 were rejected under 35 U.S.C. § 103(a) as unpatentable over Davis, Middleton, and Hensley as applied to claims 1, 10, 19 and 23, and further in view of U.S. patent 5,887,216 to Motoyama. Claims 9, 18, 27, and 36 were rejected under 35 U.S.C. § 103(a) as unpatentable over Davis, Middleton, Hensley, and Fujiyama as applied to claims 8, 17, 26, and 35, and further in view of Motoyama.

Initially, applicants note each of the independent claims is amended by the present response to clarify features recited therein. Specifically, the independent claims no longer recite an interface of a target application but now recite "an image forming device including an operation panel". The claims also clarify that the operation panel includes a plurality of operations to be selected by a user and that the monitoring unit and the communicating unit are self-contained in the image forming device. To that extent the claims recite features similarly as recited in previous pending dependent claims 3, 12, 21, and 30. With respect to the rejection to those previously pending dependent claims 3, 12, 21, and 30, the outstanding rejection cited the combination of teachings of Davis in view of Middleton, Hensley, and

further in view of Motoyama. However, applicants respectfully submit that grounds for rejection does not meet the limitations of the amended claims for the following reasons.

Davis is directed to a method for monitoring client use of and interactions with a resource downloaded from a server on a computer network (column 1, lines 33-38). The claims are believed to recite features contrary to such an operation in Davis.

As Davis requires downloading a resource to be monitored, Davis clearly requires an initial communication connection from a communication unit and a monitoring unit. If that was not the case Davis could not download the resource to be monitored.

Further, the further cited prior art to Middleton is similarly deficient.

More particularly, in Middleton communication with a web server needs to be established prior to a monitoring session, as noted at column 3, line 66, to column 4, line 1. Further, in Middleton, that establishment of communication is particularly effectuated by downloading a web page and a JAVA applet program from a web server in a web page. That applet in Middleton is obviously the critical portion of the monitoring unit in Middleton, as indicated in the basis for the outstanding rejection and the Office Action at pages 3-4, paragraph 7b.

In such ways, it is clear that in Davis and Middleton the operation of the target application and the monitoring unit is based on downloading data from a device, for example to which monitored data is to be communicated.

The claimed invention has a different structure and operation. In the claimed invention, each of the monitoring and communicating units to monitor a user's usage of an operation panel of an image forming device are self-contained in the image forming device and operate without any initial connection to an external device by the communicating unit, e.g. without a connection to a destination that is to receive the log of the monitored data.

The above-noted difference stems from the fact that the device of the claimed invention has a different objective than that in Davis and Middleton. More particularly, one objective of the device of the claimed invention is to provide a monitoring of a user's interaction with an operation panel of the image forming device to determine how the user interacts with the operation panel. Davis requires a downloading of a resource and Middleton is designed to determine a user's interaction with a web program to change the contents of the web program in essentially real-time, for example so that the user can be shown an appropriate or desired advertisement. The claimed invention does not have such objectives.

The claims also recite that the monitoring and communication operations are self-contained in the image forming device.

Further, it is clear from the claims that an external source cannot provide the monitoring and communication functions as those elements are self-contained in the image forming device, in contrast to Davis and Middleton that require elements to be downloaded from an external server.

To overcome such deficiencies in Davis and Middleton the outstanding rejection now cites the teachings in Hensley. However, it is respectfully submitted that the teachings in Davis and Middleton could not be modified to meet the above-noted claim limitations as that would destroy the entire objective of the device of Davis and Middleton.

More particularly, Davis has as a specific objective to monitor client use of and interaction with a resource downloaded from the server on a computer network. Modifying Davis to work in a contrary manner would clearly destroy the objective of the device of Davis.

Further, for the device of Middleton to operate properly it must initially download a web page; there is no other way for the web page to reach a client.

More particularly, Middleton requires the initial connection to an external server for the device of Middleton to operate. As noted above, Middleton is specifically designed to operate so that the monitored data can change the contents of a web page in real-time. Therefore, for the device of Middleton to properly operate, it must be the case that the connection is initially made prior to the monitoring or else the device in Middleton could not change the contents of the web page in real-time. Middleton also requires initial connection to download the monitoring program.

Further, in Middleton it is the actual target application itself, i.e. the web pages, that also has to be downloaded as it is a web page that is being monitored. That is also in contrast to the claims as currently written.

In such ways, Davis and Middleton could not be modified to meet the claim limitations even in view of the teachings in Hensley as that would destroy the entire objective of the devices of Davis and Middleton.

Further, the statement in the Office Action provided to modify Davis and Middleton further in view of Hensley is that “a locally stored application that may be pre-loaded on the monitored device for user-friendliness as pointed out in Hensley et al.... (column 1, lines 16-19)”.¹

In response to that basis for the outstanding rejection, applicants respectfully submit such a motivation is improper in view of the teachings of Davis and Middleton. As noted above, it is simply impossible for Davis and Middleton to properly operate if a monitoring and communication unit are pre-loaded therein. Davis and Middleton are specifically directed to monitoring operations based on downloaded data. Removing that downloading of data in Davis and Middleton destroys the entire objectives of the device of Davis and Middleton. Thus, what the Office Action indicates as providing user-friendliness in fact

¹ Office Action of March 10, 2005, top of page 5.

destroys the entire objective of the devices of Davis and Middleton. Thus, such a motivation is believed to be clearly improper.

Further, applicants respectfully submit the further cited disclosure in Motoyama does not meet the further claim limitations of the interface of the target application being “an image forming device including an operation panel”.

The outstanding rejection cites Motoyama to disclose a system for communicating a user configuration of an image forming device. However, the claims are not directed to such features. That is, the claims are not directed to communicating a status of a user configuration of an image forming device. Instead, the claims are directed to specifically monitoring how a user selects a plurality of operations on an operation panel of an image forming device. Motoyama does not disclose that type of operation. Motoyama is not directed to such a monitoring operation, and thus even if the teachings in Motoyama were combined to those of Davis, Middleton, and Hensley, the claimed invention would not be realized.

In such ways, applicants respectfully submit each of amended independent claims 1, 10, 19, and 28, and the claims dependent therefrom, patentably distinguish over the applied art.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,


OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

JJK:SNS\la

I:\ATTY\SNS\52440109-AM.DOC



James J. Kulbaski
Attorney of Record
Registration No. 34,648
Surinder Sachar
Registration No. 34,423